



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/382,426	08/24/1999	JEFFRY JOVAN PHILYAW	PHLY-24.732	5220

25883 7590 12/11/2002

HOWISON, THOMA & ARNOTT, L.L.P
P.O. BOX 741715
DALLAS, TX 75374-1715

EXAMINER

BROWN, TIMOTHY M

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 12/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/382,426

Applicant(s)

PHILYAW ET AL.

Examiner

Tim Brown

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 6 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This Final Office Action is in response to Applicants' Amendment submitted September 18, 2002. Claims 4 and 24 have been amended. Claims 1-26 are pending.

Claim Objections

2. The objection to claim 4 has been withdrawn in response to Applicants' Amendment.

Claim Rejections - 35 USC § 112

3. The rejection of claim 24 made under 35 U.S.C. §112 has been withdrawn in response to Applicants' Amendment.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. **Claims 1-6, 13-19 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (US 5,930,767).**

Regarding claims 1 and 14, Reber et al. teach a method and system for conducting an on-line transaction wherein the system provides the method comprising the steps of: entering profile information of a user into a computer at a user location disposed on a network (col. 1, lines 36-45); issuing a bar code in response to the user transmitting the profile information from the user location to a second location, the second location disposed on the network (col. 2, lines 24-30; and col. 4, lines 14-27); providing the bar code for purchase of a product of a vendor location disposed on the network, during the on-line transaction (col. 2, lines 24-30; col. 3, lines 57-59; and col. 5,

Art Unit: 3625

lines 4-15); providing the profile information from the second location to the vendor location in response to the vendor location processing the bar code (col. 5, lines 4-32); and automatically inserting the profile information into a vendor payment form for presentation to the user (col. 10, lines 44-49).

Reber et al. do not specifically teach having the user enter profile information into a form. However, the examiner takes Official Notice that using a form to collect user information over the Internet was notoriously well-known in the Internet commerce art at the time of the applicant's invention. Therefore, it would have been obvious to one having ordinary skill in the Internet commerce art, to combine the teachings of Reber et al., to include the use of a form in order to provide a formatted questionnaire that is directed at obtaining specific information.

Regarding claims 2 and 5, Reber et al. further teach a method and system wherein the user fills in the form only one time (col. 1, lines 36-45).

Regarding claims 3 and 16, Reber et al. teach all the limitations discussed under claims 1 and 14 above. Reber et al. also teach a method and system wherein the user profile information is transmitted to the second location over a public switched telephone network. Reber et al. et al. do not specifically teach the use of a form for transmitting the user profile information. However, the examiner takes Official Notice that, at the time of the applicant's invention, the use of a form was well-known in the Internet Commerce art as discussed under claims 1 and 14 above.

Regarding claims 4 and 17, Reber et al. further teach a method and system wherein the vendor location receives the profile information from the second location in

Art Unit: 3625

response to the vendor location transmitting the bar code to the second location (col. 5, lines 4-32).

Regarding claims 5 and 18, Reber et al. further teach a method and system wherein the bar code is unique and has a unique ID number associated therewith (col. 1, lines 36-45; col. 2, lines 24-32; and col. 4, lines 14-20).

Regarding claims 6 and 19, Reber et al. further teach a method and system wherein the user provides the unique ID number to the vendor location for payment purposes (col. 1, lines 36-45).

Regarding claims 13 and 26, Reber et al. further teach a method and system wherein the bar code is placed on a credit card (col. 6, lines 41-67; col. 7, lines 1-18; and Fig. 2).

2. Claims 7-9 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (US 5,930,767) in view of Wong et al. (US 5,956,699).

Regarding claims 7 and 20, Reber et al. teach all the limitations discussed under claims 1 and 14 above. Reber et al. do not specifically teach a method or system wherein automatically inserting the profile information into a vendor payment form causes all the profile information to be entered as encoded information. However, Wong et al. teach having a user encrypt his personal information, including name, address, telephone and credit card numbers before transmitting them through the Internet (col. 3, lines 38-62). Therefore, at the time of the applicant's invention, it would have been obvious to one having ordinary skill in the Internet Commerce art, to modify

Art Unit: 3625

the teachings of Reber et al. to include the use or encryption as taught by Wong et al., in order to prevent the unauthorized use of the user's personal information.

Regarding claims 8 and 21, Reber et al. teach all the limitations discussed under claims 1 and 14 above. Reber et al. do not specifically teach a method or system wherein automatically inserting the profile information into a vendor payment form causes only a portion of the profile information to be entered into the vendor payment form as encoded information. However, Wong et al. teach that a user may encrypt only his vital personal information (col. 3, lines 38-62). Therefore, at the time of the applicant's invention, it would have been obvious to one having ordinary skill in the Internet Commerce art, to modify the teachings of Reber et al. to include the teachings of Wong et al. because limiting the use of encryption would decrease the amount of processing required to decode the user's profile information. Consequently, limiting the use of encryption would decrease the overall time required to process the user's profile information.

Regarding claims 9 and 22, Reber et al. teach all the limitations discussed under claims 8 and 20 above. Reber et al. do not specifically teach a method or system wherein the portion of encoded profile information is credit information. However, Wong et al. teach that a user may elect to encrypt his credit card number (col. 3, lines 38-62). Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the Internet commerce art, to modify the teachings of Reber et al. to include the teachings of Wong et al. because encrypting only the user's credit information would limit the amount of processing required to decode the user's profile

Art Unit: 3625

information. Thus, by reducing the amount of processing required to decode the user's profile information, the overall time required to process the user's profile information is reduced.

3. Claims 10 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (US 5,930,767) in view of Green et al. (US 5,664,110).

Reber et al. teach all the limitations discussed under claims 1 and 14 above.

Reber et al. do not specifically teach a method or system wherein the user profile information comprises name, address, ship-to address and credit information.

However, Green et al. teach providing a remote vendor with the user's name, address, account information, delivery preference and consumer profile information (col. 5, lines 22-42). Therefore, at the time of the applicant's invention, it would have been obvious to one having ordinary skill in the Internet commerce art, to modify the teachings of Reber et al., to include the teachings of Green et al. because providing a remote vendor with the user's name, address, account information, delivery preference and consumer profile information would eliminate the need for the user to submit this information every time he placed an order with the vendor. This would be particularly advantageous in cases where the user submits multiple orders to the vendor.

4. Claims 11, 12, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (US 5,930,767) in view of Gardenswartz et al. (US 6,055,573).

Regarding claims 11 and 24, Reber et al. teach all the limitations discussed under claims 1 and 14 above. Reber et al. inherently teach a database of profile

Art Unit: 3625

information associated with unique bar codes. Reber et al. disclose that a user is identified by having the system read a unique bar code (col. 3, lines 56-67; and col. 4, lines 1-4). The system in Reber et al. must store identifying information that is associated with the unique bar code in order for a user to be identified by bar code. Therefore, a database of profile information associated with unique bar codes is inherent to the teachings of Reber et al.

Further regarding claims 11 and 24, Reber et al. do not specifically teach a method or system wherein the second location is a central registration server having a database of profile information associated with respective unique bar codes and unique ID numbers. However, Gardenswartz et al. teach a remotely-located registration server programmed to receive, store and/or transmit various types of information, including identifying information (col. 6, lines 54-62; and Fig. 1). The database is inherent to the teachings of Gardenswartz et al. because the registration server is programmed for the storage of information (Id.). At the time of the applicant's invention, it would have been obvious to one having ordinary skill in the Internet Commerce art, to modify the teachings of Reber et al. to include the teachings of Gardenswartz et al. because the addition of a central registration server that is capable of storing and transmitting identifying information would provide a system wherein the user could provide his profile information to a number of vendors while submitting this information to the registration server only once.

Regarding claims 12 and 25, Reber et al. teach all the limitations discussed under claims 11 and 24 above. Reber et al. do not specifically teach a method or

system wherein the second location is a credit card company server. However, the examiner takes Official Notice that, at the time of the applicant's invention, submitting a user's profile information to a credit card company server was notoriously well-known in the Internet commerce art. Therefore, at the time of the applicant's invention, it would have been obvious to one having ordinary skill in the Internet commerce art, to modify the teachings of Reber et al. to include submitting a user's profile information to a credit card company server because this would allow the user to electronically apply for a credit card.

Response to Arguments

5. Applicant's arguments filed September 18, 2002 have been fully considered but they are not persuasive.

Claims 1-6, 13-19 and 26

6. Applicants' argue "there is too much dissimilarity between their base Claims 1 and 14 and the asserted suggestions or teachings of the cited reference" (Response, page 3). The Examiner notes it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Reber et al. (US 5,930,767) ("Reber") features a method for completing transactions using a computer network (see Abstract). Similarly, Applicants' claims are directed to a method for conducting an online

Art Unit: 3625

transaction. Clearly, Reber is within Applicants' endeavor. Therefore, Reber may be relied upon as a basis for rejection of the invention.

7. Applicants' argue Reber fails to teach the step of entering profile information of a user. The Examiner respectfully disagrees as follows. Reber discloses registering a user with a service for purchasing items over the Internet (col. 1, lines 36-46; and col. 5, lines 16-22). The fact that this registration step includes receiving profile information is supported throughout Reber's disclosure. For example, Reber discloses identifying a user by associating a user's account record with a machine-readable bar code (col. 4, lines 57-59; col. 4, lines 14-18). Reber further discloses generating an invoice wherein the invoice includes a machine-readable bar code for providing a link to the user's payment resource (col. 9, lines 46-67). Without receiving some form of profile information, a user could not possibly be identified by associating him with an account record. Furthermore, the fact that Reber's system is capable of generating an invoice, including a link to the user's payment resource, indicates that at least identifying and payment information must have been provided. Therefore, Reber teaches the step of entering profile information of a user.

8. Applicants' argue Reber fails to teach how "transaction data" is provided (Response, page 3). The Examiner notes claims 1 and 14 fail to recite any limitation that indicate how the transaction data is generated. Nonetheless, Reber expressly teaches how the transaction data is received. For example, Reber discloses completing a commercial transaction by submitting a user's personal identification information through a personal computer (col. 1, lines 36-45). Reber further discloses receiving, by

Art Unit: 3625

a computer, "transaction data generated at a user location via the electronic network" (col. 2, lines 51-52). Reber further discloses receiving information indicating a party to a transaction by way of a machine readable bar code (col. 3, lines 57-59). Reber further discloses permitting a user to select items by pointing and clicking or through the use of a keyboard (col. 4, lines 59-62). Therefore, Reber teaches how transaction data is provided.

9. Applicants argue Reber fails to disclose using the profile information to complete a transaction (Response, page 3). The Examiner respectfully disagrees. Reber's disclosure expressly using a machine-readable code to identify a party to a transaction (col. 3, lines 57-59). Reber further discloses entering a user's personal identification number to complete a purchase over the Internet (col. 1, lines 36-46). Finally, Reber discloses authorizing the user's transaction by using a machine-readable to associate the user with a payment account (col. 5, lines 4-44). According to Reber, the user would not be allowed to complete a transaction without submitting at least his identification and payment information. Therefore, Reber teaches using the profile information to complete a transaction.

10. Applicants argue Reber fails to teach issuing a bar code in response to the user transmitting his profile information (Response, page 3). Specifically, Applicants assert Reber does not issue a barcode to the user for subsequent use in conducting a transaction (Id.). The Examiner respectfully disagrees. According to Reber, a user registers for the online purchasing service over the Internet (col. 1, lines 36-45). Then, the user is permitted to submit his identification and payment information to a central

Art Unit: 3625

computer in the form of a machine-readable bar code (see col. 3, lines 4-19 and 57-59; and col. 4, lines 4-31). Without issuing the user a bar code in response to his registering with the service, the user would not be able to submit the bar code for identification and payment purposes. Therefore, Reber teaches issuing a bar code in response to the user transmitting his profile information.

11. Applicants argue Reber does not teach providing profile information from the second location to the vendor location in response to the vendor location processing the bar code (Response, page 3). Specifically, Applicants contend this step "is not the same as authenticating the second data element indicating a party to a transaction as defined at Col. 2, lines 59-60" (Id.). The Examiner respectfully disagrees. First, claim 1 does not recite any limitation that restricts it from reading on an authentication step. Claim 1 merely recites that "profile information" is submitted in response to the processing of a bar code. Second, the Office Action did not cite Col. 2, lines 59-60 as disclosing the step of providing profile information from the second location to the vendor location in response to the vendor location processing the bar code. Rather, the Office Action cites Reber at Col. 5, lines 4-32 as teaching this step (see Office Action, page 3). Col. 5, lines 4-32 provide that a user's identification and payment information is provided in response to submitting a bar code to a central computer. A user's identity and payment information clearly comprises profile information. Therefore, Reber teaches providing profile information from the second location to the vendor location in response to the vendor location processing the bar code.

12. Applicants argue Reber fails to teach the step of inserting the profile information in the vendor payment form for presentation to the user (Response, page 4). The Examiner respectfully disagrees. According to Reber, the user's profile information, including name and address, is placed on a "statement of charges, such as invoice or a bill, from a creditor" (col. 9, lines 49-50) (see *also* Fig. 7). Like a vendor payment form, invoices and bills are used to complete the purchase of an item or service. Therefore, Reber teaches inserting the profile information in the vendor payment form for presentation to the user.

Claims 7-9 and 20-22

13. Applicants point out claims 7 and 20 recite inserting profile information as encoded information (Response, page 5). Applicants argue Wong et al. (US 5,956,699) ("Wong") teaches away from claims 7 and 20 by disclosing "encrypting" user profile information (Id.). The Examiner submits encrypting and encoding are equivalent terms. Under the definition for "encode," the Microsoft Computer Dictionary states "[s]ee encrypt" (Microsoft Computer Dictionary, Fifth Edition, p. 192) (emphasis original). Furthermore, "encrypt" is defined as verb that means "[t]o *encode* . . . information in such a way that is unreadable to all but those individuals possessing the key to the code" (Id.) (emphasis added). These definitions demonstrate "encrypting" is a form of "encoding." Therefore, Wong's disclosure of encrypting user information does not teach away from claims 7 and 20.

Claims 10 and 23

14. Applicants argue Green does not teach the limitations of claims 1 or 14 (Response, page 5). However, Reber and well known principles in the art disclose all the limitations of these claims as discussed above and in the Office Action (see Office Action, pages 3-5). Thus, the Examiner respectfully submits the issue of whether Green teaches the limitations of claims 1 and 14 is moot.

Claims 11, 12, 24 and 25

15. Applicants argue Gardenswartz et al. (US 6,055,573) ("Gardenswartz") does not teach a server having a database of profile information (Response, page 6).

Specifically, Applicants point out Figure 1 shows the purchase history database 8, as a separate structure from the registration server 14 (Id.). However, the Microsoft Computer Dictionary defines a server as a computer or program that may contain an archive data or program files (Microsoft Computer Dictionary, Fifth Edition, p. 474). Moreover, Gardenswartz provides that the registration server 14 identifies a customer by linking a first and second identifier *in a memory* (col. 3, lines 31-37). This step makes no mention of the separate and distinct purchase history database.

Consequently, Gardenswartz teaches a server having a database.

16. With respect to the database containing user profile information, the Examiner notes this limitation is an intended use of the invention. MPEP §2114 provides "[c]laims directed to apparatus must be distinguished from the prior art in terms of structure rather than function (citing *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA

Art Unit: 3625

1959). Therefore, storing user profile information on the database does not confer any patentable distinction.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Wright Jr. (US 5,704,029) System and method for completing an electronic form; teaches using a bar code scanner to complete form fields (col. 28, lines 30-36)
- b. Wang et al. (US 5,848,426) Automatic data transmission between different business systems
- c. Barrus et al. (US 5,465,291) Apparatus for ordering from remote locations; teaches identifying a user by scanning a bar code (col. 9, lines 55-62)
- d. Perkowski (US 5,918,214) System and method for finding product and service related information on the Internet
- e. Call (US 6,154,738) Methods and apparatus for disseminating product information via the Internet using universal product codes
- f. Nemirofsky et al. (US 5,880,769) Interactive smart card system for integrating the provision of remote and local services
- g. Chen et al. (US 5,590,197) Electronic payment system and method
- h. Lee et al. (US 6,003,014) Method and apparatus for acquiring access using a smart card

Art Unit: 3625

- i. Gupta et al. (US 6,199,079) Method and system for automatically filling in forms in an integrated network based transaction environment
- j. Davis et al. (US 6,282,522) Internet payment system using smart card

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Brown whose telephone number is (703) 305-1912. The examiner can normally be reached on Monday - Friday, 8am - 5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Art Unit: 3625

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Tim Brown
Examiner
Art Unit 3625

TB
December 4, 2002


WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600